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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,277	07/31/2000	Hiroyuki Miyoshi	9369-49(T37-124487M/TH)	4913

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EXAMINER	
BRAHAN, THOMAS J	

ART UNIT	PAPER NUMBER
3652	

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/629,277	MIYOSHI ET AL.	
	Examiner	Art Unit	
	Thomas J. Brahan	3652	

-- Th MAILING DATE of this communication appears on the cov r sh et with the correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 20 October 2003.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 2-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 2-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). There is no basis in the specification for the terms "driving section" and "drive assembly". These terms are not defined in the specification.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

3. Claims 2-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 7, it is unclear as to how the applicant is using the terms "driving section" and "drive assembly" both found in line 6. These terms are not found in the specification and it unclear as to how the actuator device is considered as having both of these similar sounding elements.

b. In claim 7, it is unclear as to how the applicant is considering the driving section and speed reducer as mounted in the machine room, as recited in lines 7 and 8. The speed reducer (20) is mounted inside the sheave, as to have it in the elevator passage, not in the machine room.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

5. Claims 2, 3, 5-7, 13-15, 19, 20, 22, and 23, as best understood, are rejected under 35 U.S.C. § 103 (a) as being unpatentable over JP 11-79627 in view of JP 8-40675. JP '627 shows the basic claimed elevator actuator device with a sheave (30), a motor (1), and a speed reducer (20). It varies from the claims by not specifying how it is mounted in its elevator passageway. JP '675 shows a similar actuator device which has its motor mounted in a recess in the passageway as to have only the sheave extending into the passage. The recess has an access door (116) and is considered as a machine room. It would have been obvious to one of ordinary skill in the art to mount the elevator actuator of JP '627 in a machine room at the top of the building with only its sheave extending into the passageway, as have it taking up minimal passageway space, as taught by JP '675. The actuator device of JP '627 has a support member (5) with the drive assembly (1) on one side and the speed reducer (20) on the opposite side, as recited in claim 2. The drive assembly, brake and speed-reducer of JP '627 are coaxially arranged, as recited in claim 3. The output of the speed reducer constitutes the sheave, as recited in claim 4. The speed reducer (20) of JP '627 is located radially inwardly of the sheave, as recited in claim 13, has rotary elements (23) contacting a cylindrical surfaces in a common plane, as recited in claims 14 and 19, and is adjacent to the drive assembly and on the same shaft, as recited in claim 15. JP '627 has a brake assembly (40) located between an end plane of the sheave and an end plane of the drive assembly (motor/brake assembly) as the term drive assembly is best understood, as recited in claim 20. The machine room of JP '675 is smaller along a horizontal direction than along a vertical direction, as recited in claim 22. The width of the motor of JP 627 is smaller than the diameter of its sheave, as recited in claim 23.

6. Claim 4, as best understood, is rejected under 35 U.S.C. § 103 (a) as being unpatentable over JP '627 in view of JP '675, as applied above to claim 20, and further in view of Hakala et al. JP '627, as modified, shows the basic claimed elevator device, but varies from claim 4 by not having the brake located radially inwardly of the motor. Hakala et al shows a similar compact elevator drive and teaches placing the brake mechanism (122, 123) within the motor. It would have been obvious to one of ordinary skill in the art to modify the actuating assembly of JP '627 by having its brake mechanism located radially within the motor, to reduce the space occupied by the actuating assembly, as taught by Hakala et al.

7. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

8. Claims 2-23, as best understood, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,520,483 (Miyoshi et al) in view of JP '675. Claims 1-7 of Miyoshi et al are drawn to the same elevator actuator recited in the claims. They vary from the claims of this application by not specifying how the actuator is mounted in the elevator passageway. JP '675 shows a similar actuator device which has its motor mounted in a recess in the passageway as to have only the sheave extending into the passage. The recess has an access door (116) and is considered as a machine room. It would have been obvious to one of ordinary skill in the art to mount the elevator actuator recited in claims 1-7 of Miyoshi et al in a machine room at the top of the building with only its sheave extending into the passageway, as have it taking up minimal passageway space, as taught by JP '675.

9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome a rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 24 would be allowable if rewritten in independent form including all the limitations of claim 7, and rewritten to overcome the rejections under 35 U.S.C. § 112. Upon the filing of a terminal disclaimer, claims 8-12, 16-18, and 21, would be allowable if rewritten in independent form including all the limitations of claim 7 and the intervening claims, and rewritten to overcome the rejections under 35 U.S.C. § 112.

11. In the amendment filed October 20, 2003, applicant argues the rejection under 35 U.S.C. § 103 (a) based upon JP 11-79627 in view of Aulanko by stating it would not have been obvious to use the actuating device of JP '627 in the arrangement shown by Aulanko (or in the similar JP '675 reference now used in the rejections) as it is for a home elevator. However this argument is not found persuasive, as the actuator of JP '627 could be used in other environments, including in a passageway with a recesses machine room such as in JP '675. If the actuator of JP '627 lacks the power for a larger job, it would be within the limits of routine skill in the art to use a similar device with sufficient horsepower. Applicant also argues that the new claim now recites a driving section having its speed reducer mounted in the machine room with the sheave projecting into the elevator passageway. However, as discussed above in paragraph 3, section b, applicant's speed reducer is not located in the machine room, but is in the passageway, as the speed reducer is located inside the sheave.

12. An inquiry concerning this action should be directed to Examiner Thomas J. Brahan at telephone number (703) 308-2568 on Mondays through Thursdays from 8:30-6:00 EST. The examiner's supervisor, Ms. Eileen Lillis, can be reached at (703) 308-3248. The fax number for Technology Center 3600 is (703) 305-7687.

12/14/03

THOMAS J. BRAHAN
PRIMARY EXAMINER